1655 #8

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Astatke *et al.*
Appl. No. 09/608,066
Filed: June 30, 2000

Art Unit: 1655
Examiner: Taylor, J.
Atty. Docket: 0942.4990001/RWE/CEJ

For: **Compositions and Methods for Enhanced Sensitivity and Specificity of Nucleic Acid Synthesis**

Reply To Restriction Requirement

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action dated December 01, 2000, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group II , represented by claims 12-18. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with** traverse. The criteria for a proper requirement for restriction are that (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. MPEP § 803.

Applicants respectfully assert that the claims in Groups II, III, IV and V are closely related in subject matter. As such, a search of one group of claims is likely to encompass subject matter pertinent to the patentability of all groups, particularly since groups II and III have been classified by the Examiner in class 435, subclass 91.1. Therefore, Applicants respectfully request that the claims of Groups III, IV and V be rejoined to provisionally elected Group II. Moreover, the Examiner has not satisfied the second requirement set forth

in MPEP § 803, *i.e.* the Examiner has not shown why a serious burden would be imposed on the Examiner if restriction were not required. It should be noted that the two requirements set forth in MPEP § 803 are connected with "and." Hence, satisfaction of both is required. The Examiner has not shown by appropriate explanation any of the three reasons supporting a serious burden if restriction were not required, as set forth in MPEP § 808.02. A serious burden therefore has not been established, and "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803. Hence, reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

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